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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,916	03/03/2000	Andrew V. Lukas	8760-021-999	7572

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PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/518,916

Applicant(s)

LUKAS ET AL.

Examiner

James Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,5,6. 6) ☐ Other:

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US Patent 6,167,383).

Henson discloses methods and computer-readable memory with instructions that permit users to optimize (customize) base products such as computers. Henson stores data in databases that may be queried to obtain and update information concerning users (including user characteristics), products (including product components) and user activity and events. For purposes of this examination, the term *optimize* will be given its broadest reasonable interpretation, "to make as perfect, effective or functional as possible."<sup>1</sup> Henson allows users to make their computers as perfect, effective and functional as possible, i.e. optimize, by guiding users via recommendations presented as menu options. For example, the system lets users know when one or more options are not compatible for one reason or another.

User information (user profile) and characteristics Henson discloses that user information is stored in various databases (Col. 2, line 60-Col. 3, line 54). Stored user information contains at least one characteristic of users, such as whether a user is an

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individual or a business (for example, Col. 13, lines 29-62). For new users, where user record may not exist, Henson creates a user record (for example, Col. 12, lines 19-39).

User information contains fields that store characteristics related to a user, such as the extent of the desire of the user to get recommendations from advisor module. For example, "help me choose" button, Fig. 4. Users can request ask and obtain recommendation (for example, Col. 3, lines 12-29). Henson also responds according to a user's interest in specific product components and their qualities. For example, see Fig. 4 and related text. Users may select options from menus to optimize base products with product components. For example, Col. 8, line 56-Col. 9, line 7, Col. 14, lines 4-Col. 15, line 45. Henson obtains identification of a user (for example, Abstract, as well as Col. 2, line 60-Col. 3, line 12). See also references to user classification, Fig. 7-10 and related text, Col. 11, line 9-Col. 12, line 61.

Product and component Information Henson discloses options for selecting components (e.g., types of computer systems and types of memory). See, for example, Fig. 5 and related text concerning memory options. Shopping carts store information concerning products, events and user activities for resumed use during different sessions. Henson updates shopping cart information to include information obtained dynamically and in response to user actions. The data is formatted and displayed according to updated information. See, for example, references to shopping carts and control by sessions, Col. 9, line 40-Col. 11, line 9). See also Fig. 6, which shows that users may store updated product and component information for later sessions.

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<sup>1</sup> Definition of Optimize, Merriam Webster's Collegiate Dictionary.

Formatted Display Henson discloses formatting display according to user characteristics. For example, Col. 11, line 63-Col. 12, line 9, which discloses formatting a display to omit questions such as company or organization name for home consumers. Henson displays formatted information concerning base products and components such as memory, monitors, video cards, etc. For example, Figs. 4 and 5 and related text. For default options, see Col. 9, lines 8-25. See also Fig. 5 for options that are presented as defaults when a formatted display is presented to a user.

Formatted display may include menus that include one or more of the following: different sets of options associated with a base product (for example, Fig. 5). Displays present correlations between a component in a product and a characteristic in a user's information when the correlation exceeds a threshold value such as lead time. See, for example, reduction of lead times according to user information and product component availability, Col. 14, line 35-Col. 15, line 8.

Henson discloses that the system may notify users via on-screen text and messages. See, for example, references to messages of gratitude (Col. 5, lines 19-28).

Product optimization Henson discloses that a product is optimized when a user indicates that said product is optimized, such as when a user clicks on a button that places an order. For example, "place order" button, Fig. 6, Col. 9, lines 40-55. Alternatively, when components and products are altered, Henson stores and displays updated pricing information. See, for example, references to Cart total (Fig. 6).

The steps described by Henson are performed reiteratively until a user has optimized a product. Henson discloses the use of selectable events to notify the system

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that a user has made a selection, or when a user requests assistance, such as when a user presses a help button. For example, Col. 13, lines 6-53.

Henson *does not* specifically use the terms "sales module" or "advisor module" to describe modules, functions and executable instructions. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to classify executable instructions according to functions and into modules such as described by Henson, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

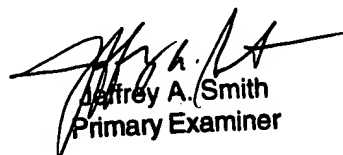
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*JZ*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
August 8, 2003

  
**Jeffrey A. Smith**  
**Primary Examiner**